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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,730	03/21/2001	Wolfgang Fraas	P01,0043	7515
21171	7590	09/28/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			JUNTIMA, NITTAYA	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/787,730	Applicant(s) FRAAS ET AL.	
	Examiner Nittaya Juntima	Art Unit 2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/21/2001</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-13 are cancelled as per the Preliminary Amendment filed on 3/21/2001.

Oath/Declaration

2. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying the priority claimed to the PCT/DE99/02889 including this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Drawings

3. (i) Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

(ii) The elements in figures 1-4 should be labeled accordingly to put the drawings in a more comprehensible form. For example, in Fig. 1, elements "B1" and "B2" would be labeled as "data channels."

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 19-20, 22, and 25-26 are objected to because of the following informalities:
- in claim 19, ll 2-3, “at lease one of,” should be deleted to make the claim more clear;
 - in claim 20, ll 2, “the” should be changed to “a,” and “IOM-2” should be spelled out to avoid any confusion;
 - in claim 22, ll 2, “or” should be changed to “and;”
 - in claim 25, ll 3, “Typ1” should be changed to “Type 1;”
 - in claim 26, ll 3, “Typ2” should be changed to “Type 2;”

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) Claim 14 is vague and indefinite due to the following:

(i) It cannot be determined from the claim language as how the step of forming a time-slot-oriented data format would be related to the rest of the steps (connecting, setting up, associating, and transmitting) since there is no linkage between the forming step and the remaining claimed steps.

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(ii) The step of “setting up ...between the switching system” is incomplete. It cannot be determined as the data transmission is being set up between the switching system and what. The office is treating this limitation as “setting up ...between the switching system and the communication terminal.”

(iii) The limitation “associate the hubs with an unambiguous address” is vague and indefinite. It cannot be determined how a plurality of hubs can be associated with just one address since the preamble calls for a method for identify a hub. The office is treating this limitation as “associate the hub with an unambiguous address.”

b) In addition, claim 14, recites the limitation “the communication terminals” in line 7 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 14 and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by Pierson, Jr. (USPN 6,272,128 B1).

Per claim 14, as shown in Fig. 1, Pierson, Jr. teaches a method for identifying a hub (ATM switch 109) connected between a communication terminal (user 145A) and a switching system (ATM switch 106), wherein a plurality of hubs (ATM switches 109, 115, and 120) are

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connected to the switching system via a communication network (ATM network 101). See col.

7, ll 35-52. The method includes the steps of:

Forming a time-slot-oriented data format (T1 frame in Fig. 2) from a periodic sequence of channel-oriented information segments (T1 frame bit 205 and T1 payload 210 in Fig. 2). See col. 8, ll 2-19.

Connecting the communication terminal to the hub (user 145A is connected to ATM switch 109, Fig. 1 and col. 7, ll 35-39).

Setting up a data transmission (data communication) between the switching system (ATM switch 106) and the communication terminal (user 145A) (since the data communication between users 140A and 145A is established, col. 7, ll 35-44 and col. 8, ll 13-17, therefore, the data communication between the ATM switch 106 to which user 140A is connected and the user 145A must also be set up to provide communication to the two users).

Associating the hub (ATM switch 109 in Fig. 1) with an unambiguous address (VPI value in a VPI field 420 of Fig. 4 of an ATM cell transmitted from ATM switch 109 to ATM switch 106 shown in Fig.1 during data communication between users 140A and 145A) in the communication network (ATM network 101, Fig. 1). See col. 8, ll 2-18 and 55-67.

Transmitting the address of a hub (VPI value in an ATM cell transmitted by ATM switch 109 in Fig. 1) via the communication network (ATM network 101 in Fig. 1) to the switching system (ATM switch 106 in Fig. 1) in an agreed information segment (a VPI field 420 shown in Fig. 4) upon request (an inherent call setup request). An inherent call setup request must be originated by a user who wants to send the data, e.g. user 140A in Fig.1, in order to start a data communication between any two users, and once the connection is set up, an ATM cell carrying

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VPI value, e.g. from ATM switch 109 to ATM switch 106, would be transmitted over the network. See col. 7, ll 35-52, col. 8, ll 2-18 and 55-67.

Per claim 15, Pierson, Jr. teaches that the request (the inherent call set up request requesting for data communication made from user 140A to 145A as explained in the rejection of claim 14) is made during a message transmission (an inherent call set up transmitted from user 140A to user 145A) from the switching system (ATM switch 106 in Fig. 1) to the communication terminal (145A). An inherent call setup request originated by user 140A must be sent as a call set up message from ATM switch 106 to user 145A via ATM switch 106 in order for the connection between the two users to be set up over ATM network 101. See col. 7, ll 35-52, col. 8, ll 2-18 and 55-67.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson, Jr. (USPN 6,272,128 B1).

Per claim 16, Pierson, Jr. fails to explicitly teach that the request is made during a message transmission from the communication terminal to the switching system.

However, as seen on Fig. 1 that user 140A is connected to ATM network 101 via ATM switch 106, and user 145A is connected via ATM switch 109. Therefore, it would have been

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obvious to one skilled in the art at the time the invention was made to include in the teaching of Pierson, Jr. that the request is made during a message transmission from the communication terminal to the switching system. The motivation/suggestion would have been to enable the communication terminal (user 145A in Fig. 1) to initiate the data communication, thereby providing an equal opportunity for any user connected to either the hub (ATM switch 109 in Fig. 1) or the switching system (ATM switch 106) to initiate such communication.

Allowable Subject Matter

10. Claims 17-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

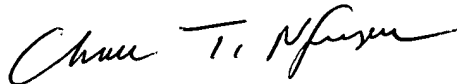
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima
September 22, 2004



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SUPERVISORY PATENT EXAMINER
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